



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 08/913,644 | 11/21/1997 | KATHRYN J. HOFMANN | 19424PC | 7265 |

7590 12/04/2003

ALYSIA A. FINNEGAN
C/O MERCK & CO., INC.
PATENT DEPT., RY60-30
PO BOX 2000
RAHWAY, NJ 07065-0907

EXAMINER

SALIMI, ALI REZA

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1648

DATE MAILED: 12/04/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/913,644

Applicant(s)

Hofmann et al

Examiner

A. R. SALMI

Art Unit

1648



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 29, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4, 11-17, and 20 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4, 11-14, and 20 is/are allowed.
- 6) ☒ Claim(s) 15-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Nov 21, 1997 is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 9 6) ☐ Other:

Art Unit: 1648

DETAILED ACTION

Response to Amendment

This is a response to the amendment A, paper No.8, filed 09/29/2003. Claims 1-3, 5-10, 18-19 have been canceled. Claims 4, 11-17, and 20 are pending before the examiner.

Claims 4, 11-17, and 20 are pending.

Raw Sequence Listing have been entered.

Submitted Information Disclosure Statement (I.D.S) is noted.

Election/Restriction

Applicant's election with traverse of Group VI in Paper No. 8 is acknowledged. The traversal is on the ground(s) that the subject matter of other Groups overlap and the search for the said groups would not provide serious burden. Upon reconsideration, applicant's arguments are persuasive regarding rejoinder of groups. Hence, claims 4, 11-17, and 20 have been rejoined.

Specification

The disclosure is objected to because of the following informalities: The disclosure comprises multiple sequence. The various sequences throughout the specification should be identified by a specific sequence identification number, i.e see page 22.

Appropriate correction is required.

Art Unit: 1648

Priority

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). Please update the priority information.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not refer to the priority applications that are present in the first sentence of disclosure.

Claim Rejections - 35 USC § 112

Claims 15, 16 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are confusing for recitation of "comprising" which indicates there are more than one element should be present. However, the claims only define one element and it is not

Art Unit: 1648

clear as to what other element is intended to be present. Is a pharmaceutically acceptable carrier intended? This affect dependent claim 17.

Subject Matter Free of over Prior art

Claims 4, 11-17, and 20 are deemed free of prior art, given failure of the prior art to teach or reasonably suggest the SEQ ID NO: 2, and SEQ ID NO: 4, the virus like particles that are formed by the said sequences and method of production and their use. The closest art identified is by Cole et al (J. Mol. Biol. 1987), but the art does not identify the sequences that are claimed.

Claims 4, 11-14, and 20 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. R. Salimi whose telephone number is (703) 305-7136. The examiner can normally be reached on Monday-Friday from 9:00 Am to 6:00 Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (703) 308-4027. The Official fax number is (703) 872-9306.

Application/Control Number: 08/913,644

Page 5

Art Unit: 1648

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

A. R. Salimi

12/3/2003

A. R. SALIMI
PRIMARY EXAMINER